

REMARKS

Summary of the Office Action

Claims 6-8 and 10-12 are indicated as allowed.

Claims 1 and 2 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,766,124 to *Taguchi et al.* (“*Taguchi*”).

Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Taguchi* in view of U.S. Patent No. 6,895,204 to *Shin*.

Summary of the Response to the Office Action

Applicants propose amending claim 1. Claims 3, 5, 9, and 13-30 have been withdrawn. Accordingly, claims 1, 2, 4, 6, 7, 8, and 10-12 are pending for further consideration.

All Subject Matter Complies with 35 U.S.C. § 102(e)

Claims 1 and 2 are rejected under 35 U.S.C. §102(e) as being anticipated by *Taguchi*. Applicants respectfully traverse the rejection for the following reasons.

Applicants respectfully submit that the Office Action has not established that *Taguchi* anticipates each and every feature of Applicants’ claimed invention and that all rejections under 35 U.S.C. § 102(e) should be withdrawn. Namely, Applicants contend that newly amended independent claim 1 recites the feature “wherein when the developing roll comes to the developing position, the approximately entire developing roll enters a triangle region formed by the approximately flat-shaped intermediate transfer member, a vertical line in contact with the intermediate transfer member, and a horizontal line in contact with the intermediate transfer member.” See at least Fig. 17 of the present invention. At least this feature is not disclosed or taught by *Taguchi*.

Taguchi discloses an image forming device. See Abstract of *Taguchi*. However, *Taguchi* fails to teach or suggest at least the above recited features of claim 1. Specifically, *Taguchi* does not disclose a developing roll that enters the triangle region when the developing roll comes to the developing position. The developing roll located at the development position is outside the claimed triangle region. See the Figure of *Taguchi* shown on page 3 of the Office Action.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(e) should be withdrawn because *Taguchi* does not teach or suggest each feature of independent claim 1.

Additionally, Applicants respectfully submit that dependent claim 2 is also allowable insofar as it recites the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

All Subject Matter Complies with 35 U.S.C. § 103(a)

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Taguchi* in view of *Shin*. Applicants respectfully traverse the rejection for the following reasons.

Applicants respectfully submit that dependent claim 4 includes the features of independent claim 1 including “wherein when the developing roll comes to the developing position, the approximately entire developing roll enters a triangle region formed by the approximately flat-shaped intermediate transfer member, a vertical line in contact with the intermediate transfer member, and a horizontal line in contact with the intermediate transfer member.” At least these features are absent from, and are neither disclosed nor taught, alone or in combination, by either *Taguchi* or *Shin*.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations.

The Office Action has not established a *prima facie* case of obviousness at least because neither *Taguchi* nor *Shin*, whether alone or in combination, teach or suggest all the recited features of newly amended independent claim 1. Namely, neither *Taguchi* nor *Shin* teach or suggest at least “wherein when the developing roll comes to the developing position, the approximately entire developing roll enters a triangle region formed by the approximately flat-shaped intermediate transfer member, a vertical line in contact with the intermediate transfer member, and a horizontal line in contact with the intermediate transfer member,” features recited in claim 1. That is, *Shin* does not make up for the above-demonstrated deficiencies of *Taguchi*.

As pointed out in M.P.E.P. § 2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). As such, Applicants respectfully assert that the third prong of *prima facie* obviousness has not been met. Therefore, Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) should be withdrawn because *Taguchi* and *Shin* do not teach or suggest each and every feature of newly amended independent claim 1.

Additionally, Applicants respectfully submit that dependent claim 4 is also allowable insofar as it recites the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the Response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

By: Mary Jane Bdsweil
Mary Jane Bdsweil
Reg. No. 33,652

Dated: December 4, 2006

CUSTOMER NO.: 009629
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Tel: 202-739-3000
Fax: 202-739-3001